



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,900	02/26/2002	Hisaaki Gyoten	10059-410US(P23466-01)	5187

570 7590 08/23/2004

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

ALEJANDRO, RAYMOND

ART UNIT

PAPER NUMBER

1745

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/069,900

Applicant(s)

GYOTEN ET AL.

Examiner

Raymond Alejandro

Art Unit

1745

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1 and 4.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 3. Applicant's reply has overcome the following rejection(s): the double patenting rejection has been overcome because a terminal disclaimer has been submitted to obviate such rejection.

Response to Arguments

1. Applicant's arguments filed 08/03/04 have been fully considered but they are not persuasive.

2. The main contention of applicants' arguments is premised on the assertion that the prior art of record "*does not disclose use of vitreous carbon having the specific surface area*" and/or that "*it is apparent that the surface area of the electroconductive particles of Saito application must be designed as large as possible in order to provide the porosity necessary to hold water*". In this regard, it is first noted that "*vitreous carbon*" is also known in the art as "*glassy carbon*". It is secondly noted that the recited carbon material (i.e. *the carbon powder per se*) covers a very large number of applicable materials which can be used therefor, thus, it is then contended that any composite layer comprising any vitreous/glassy carbon powder would produce can exhibit the specific surface area. It is thirdly noted that the limitation "a specific surface area of less than 100 m²/g" does include 0 (zero) as a lower limit. Thus, the foregoing limitation might also read on 0 m²/g (thus, if the specific surface area of a material is 0 m²/g, then, either no material is positively present, and/or such specific surface area limitation is not further limiting the claim as the claim language fails to positively recite so). See MPEP 2173.05(c) *Numerical Ranges & Amounts Limitations, II. Open-Ended Numerical Ranges*.

All of the above said and given that the examiner has provided a substantive sound basis (in fact) and a technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, and therefore, to assert that the specific claimed surface area is inherent to the very same nature of the vitreous/glassy carbon of the prior art reference because *products of identical chemical*

composition can not have mutually exclusive properties. Applicants' attention is particularly directed to page 9, 1st paragraph presented in body of the final rejection. In consequence, the prior art's glassy carbon material seems to be identical except that the prior art is silent as to an inherent property and/or characteristic. In that, it is noted that the extrinsic evidence makes clear that the missing descriptive matter is necessarily present in the specific method described in the reference, and that it would be so recognized by persons of ordinary skill. As a result, once a reference teaching method appearing to be substantially identical is made the basis of the rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the application to show an unobvious difference. Hence, applicants need to prove the prior art does not necessarily or inherently possess the characteristics, and/or properties of his/their vitreous carbon powder. *In re Fitzgerald* 205 USPQ 594, 596 and *In re Best* 195 USPQ 430 (See ***MPEP 2112. Requirements of Rejection Based on Inherency***).

Accordingly, the examiner further asserts that it is not enough that applicant's representative personally believes that the prior art does not disclose the such inherently identified property and/or characteristic. That is to say, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of inherent anticipation/obviousness. That is to say, a statement or argument by the attorney is not factual evidence. (See ***MPEP 716.01 and 2145 Consideration of Applicant's Rebuttal Arguments***).

3. With respect to applicants' arguments that "*the present invention provides an electroconductive resin layer comprising a resin having water-repellant and/or basic radicals*"

Art Unit: 1745


(see the amendment-after final dated 08/03/04 at page 4, last paragraph); the examiner likes to point out that the present claim language simply recites "*said electroconductive resin layer comprises a resin having at least one of water-repellant and basic radicals*" (see claim 1, lines 14-15). Therefore, the instant claim language also allows the inclusion of at least one of them.

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *In this case, the three references are relevant to each other as they all address the same problem of providing suitable separators for a fuel cell environment and, they all are, at least, reasonably pertinent to the particular problem with which the applicant was concerned.*

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*The particular composition of the electroconductive resin layer of the separators in the fuel cell of the present invention was developed to solve the problem of corrosion of the metal substrate of the separator and resultant damage to the membrane electrode assembly (MEA) due to metal ions leaching from the metal substrate of the separator in the MEA*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 1745

6. In response to applicant's argument that: a) *"the prior art solutions have been inadequate....because the stable passive state layer provided on the substrate increases contact resistance, or there are problems with durability"*; b) *"the Saito patent is directed to producing a fuel cell separator having superior hydrophilicity and water holding capacity, while at the same time having electrical resistance"*; c) *"it is apparent that the surface area of the electroconductive particles of Saito application must be designed as large as possible in order to provide the porosity necessary to hold water"*, the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).


Patrick Ryan
Supervisory Patent Examiner
Technology Center 1700

